

PATENT

Applicant: John Simard
Serial No.: 10/620,787
Filed: 07/15/2003
Title: IMMUNOGENIC COMPOSITIONS
DERIVED FROM POXVIRUSES
AND METHODS OF USING
SAME

Examiner: Sharon L. Hurt
Group Art Unit: 1648
Atty Docket No.: 51300-00006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement in the Office Action mailed on February 22, 2006, Applicant provisionally elects Group I, claims 1-2, 7-11 and 18-26, drawn to a polyprotein comprising external immunogens of membrane associated proteins of variola major for examination. Additionally, Applicant provisionally elects Group A, drawn to the M1R protein. Applicant makes both these elections with traverse.

Regarding the election of Group I, Applicant also requests that Group II, Claims 1-2, 7-11 and 18-26, drawn to a polyprotein comprising external immunogens of membrane associated proteins of vaccinia virus should also be examined. Groups I and II are both classified in class 435, subclass 91.33 indicating that they have not attained recognition in the art as a separate subject for inventive effort (MPEP §808.02(A)). Applicants do not agree that a separate search is required for the polyproteins of Groups I and II and therefore respectfully requests that both Groups I and II be examined. Applicant further urges the Examiner to take into consideration that

the subject matter of each of the claim Groups I and II is linked by a common inventive concept.

Additionally, Group I is drawn to a product, Group VI is drawn to a method of inducing an antibody response comprising administering the product of Group I (a process of using) and Group IX is drawn to a method of making an immunogen of Group I (a process of making). Applicant requests that if the product claims are found allowable, the withdrawn process claims that depend from or otherwise require all of the limitations of an allowable product claim will be considered for rejoinder.

Applicant was requested to elect one of Group A-L. Applicant provisionally elects Group A, M1R protein, with traverse. The Examiner states on Page 4 that "the different inventions, may represent structurally different polyproteins." The proteins of Groups A-L, however, are not polyproteins, but individual proteins that are used in the construction of polyproteins. Applicant respectfully asserts that restriction to one individual protein from Groups A-L is inappropriate because the Applicant's invention comprises a polyprotein which is defined in the specification as "more than one protein, or polypeptide, made as a result of a single transcriptional event that has not been cleaved into individual protein, or polypeptide chains. The polyprotein can, or can not have linker regions connecting the individual proteins or polypeptides." (paragraph 0027). The proteins identified in Groups A-L are individual proteins and therefore restriction of the claims to only one of these individual proteins results in the inability to form a polyprotein, which is what Applicant regards as his invention.

"It is improper to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature essential to the utility." (MPEP §803.02)

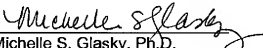
The proteins of Groups A-L share a common utility in that they are immunogenic poxvirus membrane associated proteins able to induce an immune response reactive with variola major. Secondly, they share a substantial structural feature essential to the utility in that they are all proteins which is essential for inducing an immune response to a poxvirus. Therefore the proteins of Groups A-L have a unity of invention and the restriction between the proteins of Groups A-L is inappropriate.

Consequently, Applicants respectfully request the Examiner to reconsider the restriction requirement and examine Groups I and II as well as the proteins of Groups A-L.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-3207.

Respectfully submitted,

Dated: 3/22/06


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